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THE OFFICE ACTION**Remarks/Arguments**

Applicant has now had an opportunity to carefully consider the Examiner's comments set forth in the Office Action of January 7, 2004.

Claims 7 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 3, 4, 9 and 10 were rejected under 35 U.S.C. §103(a) as being unpatentable over Caldwell--U.S. Patent No. 4,403,895 ("Caldwell") in view of Hamamoto--U.S. Patent No. 5,695,666 ("Hamamoto") and in further view of Harris -- U.S. patent No. 3,225,641.

Claims 11, 12 and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Caldwell--U.S. Patent No. 4,403,895 ("Caldwell") in view of Hamamoto--U.S. Patent No. 5,695,666 ("Hamamoto").

Claims 2, 7-9 and 13 were rejected under 35 U.S.C. §103(a) as being unpatentable over Caldwell--U.S. Patent No. 4,403,895 ("Caldwell") in view of Hamamoto--U.S. Patent No. 5,695,666 ("Hamamoto") and Harris--U.S. patent No. 3,225,641 and further in view of Schmid--U.S. Patent No. 5,252,016.

Claims 16, 18-20 and 22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Caldwell--U.S. Patent No. 4,403,895 ("Caldwell") in view of Hamamoto--U.S. Patent No. 5,695,666 ("Hamamoto") and in further view of Grenell--U.S. patent No. 4,271,554.

The Examiner will appreciate that selected claims have been amended or cancelled to provide a more complete scope of protection for the invention.

Further, the Examiner will appreciate that claim 7 has been amended to clarify the dependency of the claim from independent claim 1. The Examiner's assistance in identifying this oversight is appreciated.

Reexamination and reconsideration are respectfully requested.

REMARKS**I. Claim Rejections – 35 USC §112**

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With respect to claim 7, the applicant respectfully submits that the claim has been amended to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

II. The Rejection Under 35 U.S.C. § 103(a) Has Been Overcome

A. The Rejection of Claims 1, 3, 4, 9 and 10 Under 35 U.S.C. §103(a) Has Been Overcome

With regard to independent claim 1, the applicant respectfully disagrees with the Examiner that Caldwell and the modifying references of Hamamoto and Harris teach or suggest all the limitations of claim 1. Particularly, Caldwell teaches a dimension between radial shoulders 34 and 40 that "is less than the thickness of carpet layer 20, [and as a result] carpet layer 20 will be compressed therebetween as radial shoulder 34 moves below urethane layer 22. This serves to pull flange 44 into carpet layer 20, compressing it slightly as can be seen in Figure 1." (Col. 3, lines 35-39.) The desired result of Caldwell is the compression so that the floor mat can be attached to the carpet without any bulging. This is not the case in Hamamoto or Harris, nor would such an arrangement be desirable. As such, it would not have been obvious for one of ordinary skill in the art to utilize a Caldwell retainer in a weatherseal assembly.

This is also not the case in the present application, nor would such an arrangement be desirable. Rather, in the present application, the fastening peg pierces the surface of the weatherseal to form an opening. Upon rotation and axial advancement of the fastening peg, the material of the weatherseal expands around the helical thread and then deforms radially inward behind the first flange. The second flange abuts against the planar surface of the weatherseal without passing through the self-pierced opening. Thus, the weatherseal cavity allows the fastening peg to be secured thereto without damaging the remainder of the weatherseal, particularly the bulbous portion of the weatherseal. The weatherseal rib serves as a separating wall between the first and second cavities so that even though the first cavity is pierced by the fastening peg as described above, the second cavity is not affected.

Moreover, Caldwell does not relate to a concept that would cause one of ordinary skill in the art to seek to modify the express teaching of Caldwell in a manner that fairly teaches the subject invention. Particularly, applicant respectfully disagrees with the Examiner that Caldwell teaches a self-piercing conical end adapted to pierce an

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elastomeric material. The Caldwell retainer comprises a "lower threaded mounting portion 26...[that] Includes a tapered shank 30 having a self-piercing point 32." (Column 2, lines 6-64). Such an arrangement is analogous to a metal screw, not a device for piercing an elastomeric material. Further, Caldwell only teaches a locking assembly adapted to secure the floor mat to the carpet. The purported Caldwell locking assembly is simply a hexagonal faced upper head 50 and the "holes 18 in the floor mat 16 are fitted over head 50 to retain the floor mat in place." (Column 3, lines 45-46). This is not the case in the present invention. Rather, in the present application, the locking assembly includes first and second detachable locking arms that spring or flex outwardly to secure the weatherseal to an associated mounting surface. The locking arms extend outward from the mounting surface. As such, it would not have been obvious for one of ordinary skill in the art to use the retainer of Caldwell in combination with the weatherseal disclosed in Hamamoto or the weatherseal of claim 1 of the present invention.

Finally, the applicant respectfully submits that Hamamoto and Harris disclose a weatherseal having mounting openings adapted to receive the Hamamoto clip or the Harris apparatus. Conversely, claim 1 further comprises a weatherseal that does not include mounting openings adapted to receive the fastening peg thus the reason for the self-piercing nature of the present invention. The piercing nature must be terminated to prevent continued boring into the weatherseal that would otherwise damage the integrity of the sealing bulb. Notably, no sealing bulb is shown, described or suggested in Caldwell, Hamamoto or Harris.

Moreover, applicant respectfully traverses the Examiner's characterization of Harris. The Examiner states that element 196 is a shoulder that cooperates with flange 195 "where a dimension therebetween is shown to be greater than the thickness of the weatherseal." First, element 196 is a stem portion "including plural abutment means projecting laterally outwardly thereon to engage a mounting panel." (Col. 4, lines 63-65). In other words, the stem portion is more closely akin to the locking assembly limitation of claim 1. Second, there is no shoulder or its equivalent shown or suggested in Harris, and to interpret a portion of stem portion 196 as a shoulder is directly contrary to the express teachings of Harris. Third, even if the Examiner's position is correct, it is mere speculation that the dimension between shoulder and stem portion is greater than

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the weatherseal dimension. This is mere conjecture or speculation on the part of the Examiner, and one skilled in the art would not be motivated to combine Harris with Caldwell and/or Hamamoto as suggested by the Examiner because opening A in the sealing strip preexists in Harris. Thus, the reason and motivation to combine does not exist.

Because one skilled in the art would not be prompted to use the teachings of Hamamoto and Harris with Caldwell, it is not fair to conclude that the teachings can be properly combined. Accordingly, the references cited by the Examiner fail to teach or suggest all the limitations of claim 1 and, consequently, claims dependent or ultimately dependent from claim 1. For at least this reason, the cited references do not render claims 2-4 and 7, 9, 10, and 15 dependent therefrom obvious.

B. The Rejection of Claims 16, 18-20 and 22 Under 35 U.S.C. §103(a) Has Been Overcome

With regard to independent method claim 16, the Examiner cites the Grenell patent for teaching "that it is known to self-pierce a substrate by initially drilling at a first rotational velocity while then advancing the threads at a second, slower rotational velocity (column 7, lines 17-22)." From this, the Examiner concludes that Grenell is properly combinable with Caldwell and Hamamoto to meet the claim limitations. This interpretation and ultimate conclusion of unpatentability are respectfully traversed. First, Grenell is directed to drilling and tapping issues associated with metal work pieces (column 1, lines 61-63; column 2, lines 18-19), whereas the present application is directed to non-metal application, particularly a weatherseal which is usually an elastomeric material.

Moreover, the teaching in Grenell is not directed to two different rotational velocities as suggested by the Examiner but is directed to a combination drill and coining tap tool. Accordingly, Grenell, if combined with Caldwell and Hamamoto, would actually teach away from the express limitations of claim 16 requiring rotating the peg at a first rotational velocity and subsequently rotating the fastening pin at a slower, second rotational velocity. Since one skilled in the art would not be prompted to use the teachings of Grenell with Caldwell and Hamamoto, it is not fair to conclude that the teachings can be properly combined. Accordingly, the references cited by the Examiner fail to teach or suggest all the claim limitations of claim 16 and, consequently, claims

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dependent or ultimately dependent from claim 16. For at least this reason, the cited references do not render claims 18-20 and 22 dependent therefrom obvious.

CONCLUSION

For the reasons detailed above, it is respectfully submitted all claims remaining in the application (Claims 1- 22) are now in condition for allowance.

No additional fee is believed to be required for this Amendment. If, however, a fee is due, the Commissioner is authorized to charge our Deposit Account No. 06-0308.

In the event the Examiner believes a telephone call would expedite prosecution, he is invited to call the undersigned.

Respectfully submitted,

FAY, SHARPE, FAGAN,
MINNICH & McKEE, LLP

Date: 06 April, 2004

Timothy E. Mauman
Timothy E. Mauman
Reg. No. 32,283
1100 Superior Avenue - 7th Floor
Cleveland, Ohio 44114-2579
(216) 861-5582 (phone)
(216) 241-1666 (facsimile)

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